No. 01-95

IN THE

Supreme Court of the United States

KIMBERLY-CLARK CORPORATION,

Petitioner,

v.

TYCO INTERNATIONAL (US), INC.,
THE KENDALL COMPANY, INBRAND CORPORATION,
AND CONFAB, INC.

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITIONER'S REPLY TO RESPONDENTS' BRIEF IN OPPOSITION TO PETITION

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August 21, 2001

WILSON-EPES PRINTING CO., INC. – (202) 789-0096 – WASHINGTON, D. C. 20001

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PETITIONER'S REPLY TO RESPONDENTS' BRIEF IN OPPOSITION TO PETITION[1]

Respondents' opposition does not quarrel with the primary and fundamental rule of claim construction that the Federal Circuit abandoned in this case. Thus, the new approach prescribed by the Federal Circuit's opinion is to deny that the language of patent claims controls the scope of the patent and to allow limitations to be read into clear, broad claim language. Nonetheless, the opposition attempts to mollify the effect of the Federal Circuit's departure from the settled rule based on claim language by arguing that the decision was nonprecedential and that sources aside from the text of the claims are so compelling that they ought to override the claim text. This is nothing more than an assault on the rule that

[1] The Rule 29.6 Statement appears at p. ii of the petition.

courts must presume that the terms in the claim mean what they say. The opposition's misguided reliance upon sources other than the claim text should not obscure the focus of the petition: the petition does not concern the erroneous application of fundamental claim construction rules; it concerns the failure to employ those rules at all.

I. THE FEDERAL CIRCUIT DISTURBED SETTLED PRECEDENT BY SELECTIVELY DISREGARDING RULES OF CLAIM CONSTRUCTION.

Nowhere in the Federal Circuit's "Discussion" section of its opinion does the court discuss the actual text of the Enloe II and Enloe III patent claims that refers generically to "a pair of barrier cuffs." (JA114.) The opposition attempts to gloss over this unorthodox omission from the court's analysis by pointing out that the court reproduced claim 1 of the Enloe I patent in the "Background" section of its opinion. Opp. 11-12. But this is wholly beside the point because, as the Federal Circuit recognized in its opinion, Pet. App. 5a, Petitioner did not dispute that the claims of Enloe I were limited to fluid pervious flaps. A reading of the court's opinion reveals that the court neither grappled with the claim language of the Enloe II or Enloe III patents, nor gave any weight to the fact that the relevant language does not contain any limitation concerning the material from which the barrier cuffs (or flaps) are constructed. The opposition characterizes the court's opinion as focusing on "whether or not the word flaps (or its equivalent) . . . should be interpreted as being limited to fluid pervious ones." Opp. 12. Aside from the fact that the claims being constructed do not contain the word "flaps," (JA114, 130), the opposition mischaracterizes the court's analysis. The court did not delve into the etymology of the term "flaps" ("or its equivalent"), but instead considered other sources, wholly apart from the claim text, and decided that a fluid pervious limitation should be read into and curtail the broad claim text. Cf. *Johnson Worldwide Assocs., Inc.* v. *Zebco Corp.*, 175 F.3d 985, 989 (Fed. Cir. 1999) ("modifiers [are]

not to be added to broad terms standing alone"). The opposition does not persuasively justify this unorthodox analysis.

Similarly unpersuasive is the opposition's attempt to explain the court's refusal to apply the doctrine of claim differentiation. The Respondents argue that the Federal Circuit concluded that Claim 26 of Enloe II is not "a claim to fluid pervious flaps." Opp. 15. The court did not draw such a conclusion, however, Pet. App. 8a, but instead stated that the doctrine did not apply because

> the doctrine of claim differentiation cannot in any event alter a definition that is otherwise clear from the claim language, the written description, and the prosecution history.

Id. Because the court below did not give consideration to the claim language, however, the assertion that the definition is "otherwise clear" as an excuse for not applying the doctrine rings hollow, and thus merely represents another rule of claim construction inappropriately set aside by the Federal Circuit.[2]

II. THE SPECIFICATION LANGUAGE DESCRIBES A PREFERRED EMBODIMENT THAT SHOULD NOT BE READ TO LIMIT THE GENERIC CLAIM LANGUAGE.

The plain meaning of the claim language is bolstered, not refuted, by the specification language. As recognized by the Federal Circuit, the written descriptions specifically state that the "'preferred material for the flaps . . . is a liquid pervious material.'" Pet. App. 6a (omission in original). This description of liquid pervious material as "preferred" necessarily implies what the claim language sets forth explicitly: a claim to generic barrier cuffs without limitation as to the material from which those barrier cuffs are

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[2] As mentioned in the Petition, the Federal Circuit's claim construction rendered independent Claim 26 entirely superfluous. Pet. 17.

constructed. Both logic and previous Federal Circuit caselaw dictate that a description identifying a device as "preferred" cannot limit the generic, claimed invention to that preferred device or embodiment. See, *e.g.*, *Karlin Tech. Inc.* v. *Surgical Dynamics, Inc.*, 177 F.3d 968, 973 (Fed. Cir. 1999); *Texas Instruments, Inc.* v. *United States Int'l Trade Comm'n*, 805 F.2d 1558, 1563 (Fed. Cir. 1986) ("This court has cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification."). But in this case the Federal Circuit arbitrarily refused to give this language its plain effect while seizing on other specification language stating that "'[t]he present application teaches an improved disposable garment which provides fluid pervious flaps.'" Pet. App. 6a (alteration in original). Rather than treating the claim language as paramount and reading the two specification statements so as to give the plain claim language its full and broad effect, the court read one of two specification statements to override both the claim language and the other specification statement. This, too, was contrary to previously settled law. See, *e.g.*, *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (courts are not to narrow broad claim language with limitations found in the specification unless the restriction is set forth "with reasonable clarity, deliberateness, and precision"); *Markman* v. *Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996); *Digital Biometrics, Inc.* v. *Identix, Inc.*, 149 F.3d 1335, 1344 (Fed. Cir. 1998).

While the Federal Circuit ignored claim construction rules that highlight the importance and dominance of claim text, the court also misread the applicable prosecution history. The opposition, like the Federal Circuit, incorrectly concludes that the narrowing of Claim 1 in the Enloe I application to fluid pervious barrier cuffs (or flaps) necessarily means that Petitioner abandoned its claim of fluid impervious flaps for all time. Opp. 13. While the Federal Circuit has taken a similarly stunted approach to employing selective portions of

prosecution history in another context, see *Festo Corp.* v. *Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000), *cert. granted*, 121 S. Ct. 2519 (2001), the prosecution history of Enloe II and Enloe III – the actual patents being construed – reveals that Enloe's broad invention was not, in fact, abandoned.

After Enloe provoked an interference with the Lawson patent – which indisputably claimed both fluid pervious and fluid impervious barrier cuffs – Enloe won the interference. (JA2466.) Respondents argue that Enloe's decision not to appeal from the Board of Patent Appeals and Interferences' denial of a motion to add claims directed to fluid impervious flaps constitutes an abandonment of such claims. Opp. 13. But Petitioner's position is that the Enloe II and Enloe III claims cover "barrier cuffs" generically – both fluid pervious and fluid impervious. "Barrier cuffs" as such are obviously shown in Enloe's specification, and by granting Enloe his victory in the interference, the Patent Office necessarily determined that Enloe was the first inventor of generic "barrier cuffs" and was entitled to the broad, generic claims of a pioneer. As a practical matter, Enloe did not need narrow claims directed only to fluid impervious barrier cuffs, because the generic claims that Enloe obtained after the interference properly cover all barrier cuffs, whether pervious or not.

In addition to reading the Board's denial opinion to say more than it does, Respondents attempt to explain how the Federal Circuit's opinion is not inconsistent with the claim construction rule recognized in *In re Spina*: "When interpretation is required of a claim that is copied for interference purposes, the copied claim is viewed in the context of the patent from which it was copied." 975 F.2d 854, 856 (Fed. Cir. 1992). While the opposition goes to great lengths attempting to explain how this rule does not support reading the text of the claim at issue as broadly as it is written, the Federal Circuit's opinion does not mention or consider this rule of construction at all.

Respondents point to the opinion in *Cultor Corp.* v. *A.E. Staley Manufacturing Co.*, 224 F.3d 1328 (Fed. Cir. 2000), to avoid the rule in *Spina*. Opp. 16-18. In *Cultor Corp.* the court held that the very specific disclaimer expressed in the patent's specification would not support a broad reading of the copied claim. *Cultor Corp.*, 224 F.3d at 1332. But a review of the disclaiming specification language in *Cultor Corp.* contrasts sharply with the Enloe specification, which describes liquid pervious flaps as a preferred embodiment (thus conveying the clear implication that the patent claim also encompasses impervious flaps). The *Cultor Corp.* specification stated as follows:

> "As used herein, the expression 'water-soluble polydextrose' . . . *specifically* refers to the water-soluble polydextrose prepared by melting and heating dextrose . . . in the presence of a catalytic amount . . . of citric acid."

Id. at 1330 (emphasis added). The patent claims copied, by contrast, "were not limited to polydextrose produced by using citric acid as a catalyst." *Id.* at 1332. The *Cultor Corp.* court simply did not ignore the specific and explicit disclaimer.

The *Cultor Corp.* opinion therefore is fully consistent with the *Spina* rule that the patent from which claims are copied is an important source upon which to draw when constructing the copied claims. See *Spina*, 975 F.2d at 856. Because some of Lawson's dependent claims (which are necessarily encompassed by the independent claim copied by Enloe, see Pet. 19) limit themselves to fluid impervious barrier cuffs, the copied claim that became a part of the Enloe II patent must also encompass the fluid impervious barrier cuffs. Thus, the "context of the patent from which [Claim 1 of the Enloe II patent] was copied," *Spina*, 975 F.2d at 856, confirms the plain and broad language of that claim's text.

III. THE UNPUBLISHED NATURE OF THE FEDERAL CIRCUIT'S OPINION DOES NOT CURE ITS HARMFUL EFFECT.

According to the opposition, even if the Federal Circuit's opinion does seriously flaunt previously settled rules of claim construction, this Court should ignore the issue. The opposition maintains that the decision will have no effect beyond this case because the Federal Circuit has declared that its opinion is not precedent. Opp. 9-11. The fact that the Federal Circuit decided to issue its unsettling opinion as an unpublished opinion, however, does nothing to ameliorate the perverse incentives the decision creates. To the contrary, the unpublished nature of the decision and its consequential lack of precedential authority, in combination with the exclusive jurisdiction granted to the Federal Circuit over appeals in cases related to patents, see 28 U.S.C. § 1295(a)(1), ossifies the ruling and its effects. As the opposition notes, litigants before the Federal Circuit are barred by Federal Circuit rule from citing unpublished rulings, see Fed. Cir. R. 47.6, thereby greatly reducing the likelihood that the Federal Circuit will reconsider its own erroneous ruling. This does not result, however, in the opinion having less importance in practice. Practitioners have ready access to the unpublished opinions through electronic means, and though the decision may not carry precedential weight in arguments before the Federal Circuit, the decision does constitute a precedent in the broader sense that what the court has done before, it likely will do again. Members of the patent bar drafting patent applications and advising clients will still be guided by the court's unsettling opinion. This opinion, as discussed in the Petition, Pet. 13-14, will affect the way that future patent applications will be drafted; it will drive information away from the public domain; and it will disrupt the expectations of parties to assignments, licensing agreements, and other transactions already made based on the previously settled rules of claim construction.

CONCLUSION

For the foregoing reasons and those stated in the petition, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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